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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,010	12/04/2001	Alexander H. Borchers	RTS-0345	7968

7590

07/15/2003

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EXAMINER

ZARA, JANE J

ART UNIT

PAPER NUMBER

1635

18

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No.
10/007,010

Applicant(s)
Borchers et al

Examiner
Jane Zara

Art Unit
1635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 8, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-10, and 12-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10, and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

File

Application/Control Number: 10/007,010

Page 2

Art Unit: 1635

DETAILED ACTION

This Office action is in response to the communications filed January 27, 2003 and May 8, 2003, Paper Nos. 8 and 11.

Claims 1, 2, 4-10 and 12-15 are pending in the instant application.

Any rejections not repeated in this Office action are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restriction

Applicant's election with traverse of SEQ ID NO: 3 in Paper No.11 is acknowledged. The traversal is on the ground(s) that target sequences of SEQ ID NO: 3 and SEQ ID NO: 10 are not patentably distinct and furthermore search of both of these sequences does not present a serious burden to the examiner. This is not found persuasive because SEQ ID NO: 3 (comprising 2015 nucleotides) and SEQ ID NO: 10 (comprising 30,000 nucleotides) represent different and distinct nucleotide sequences that are structurally and functionally and patentably distinct and searches required for both sequences does pose an undue burden upon the examiner.

The requirement is still deemed proper and is therefore made FINAL.

SEQ ID NO: 10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Art Unit: 1635

This application contains claim 1 drawn to an invention (SEQ ID NO: 10) nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Amendments and Arguments

Maintained Rejections

Claims 1, 2, 4, 5, 12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wei et al for the reasons of record set forth in the Office action mailed August 8, 2002, Paper No. 6.

Applicant's arguments filed January 27, 2003 have been fully considered but they are not persuasive. Applicants argue that Wei et al discloses an antisense oligonucleotide between 8-50 nucleobases that targets the initiation codon region of SEQ ID NO: 3 and this region is not included in the language of amended claim 1. Contrary to Applicants' assertions, claim 1 is drawn to antisense compounds (oligonucleotides) between 8-50 nucleobases that specifically target the 5'-UTR and coding region of SEQ ID NO: 3, and inhibits the expression of SEQ ID NO: 3 in vitro. The initiation codon is included within both the 5'UTR and the coding region of SEQ ID NO: 3 (e.g. the initiation codon, ATG, encodes the first codon of the coding region of SEQ ID NO: 3, and is adjacent to the 5'UTR). Therefore, Wei properly anticipates the compositions embodied within amended claim 1 and the 102 rejection is hereby maintained.

Art Unit: 1635

Claims 1, 2, 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei et al, in view of Quintrell et al, Lichtenberg et al and Milner et al, for the reasons of record set forth in the Office action mailed August 8, 2002, Paper No. 6.

Applicant's arguments filed January 27, 2003 have been fully considered but they are not persuasive. Applicants argue that since Wei et al disclose an antisense oligonucleotide between 8-50 nucleobases that targets the initiation codon region of SEQ ID NO: 3, and since this region is not included in the language of amended claim 1, Wei does not anticipate the claimed invention. Contrary to Applicants' assertions, claim 1 is drawn to antisense compounds (oligonucleotides) between 8-50 nucleobases that specifically target the 5'-UTR and coding region of SEQ ID NO: 3, and inhibits the expression of SEQ ID NO: 3 in vitro. The initiation codon is included within the 5'UTR and coding region of SEQ ID NO: 3 (e.g. the initiation codon, ATG, encodes the first codon of the coding region of SEQ ID NO: 3, and is adjacent to the 5'UTR). Therefore, Wei properly anticipates the compositions embodied within amended claim 1 and, in combination with the teachings of Quintrell et al, Lichtenberg et al and Milner et al, render the claimed invention obvious. Therefore, the 103 rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1635

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(703) 306-5820**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a

Application/Control Number: 10/007,010

Page 6

Art Unit: 1635

general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


KAREN LACOURCIERE
PATENT EXAMINER

JZ

July 10, 2003